

1 The opinion in support of the decision being entered today
2 is *not* binding precedent of the Board

3

4 UNITED STATES PATENT AND TRADEMARK OFFICE

5

6

7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

9

10

11 *Ex parte* LAWRENCE HOWELL SAWYER,
12 MICHAEL JOHN NIEMEYER, and
13 LORI TASSONE HOLMES

14

15

16 Appeal 2006-3438
17 Application 09/939,061
18 Technology Center 3700

19

20

21 Decided: September 26, 2007

22

23

24 *Before:* TERRY J. OWENS, MURRIEL E. CRAWFORD and
25 LINDA E. HORNER, *Administrative Patent Judges.*

26

27 CRAWFORD, *Administrative Patent Judge.*

28

29

30 DECISION ON APPEAL

31

32 STATEMENT OF CASE

33

34 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
35 of claims 1 to 39, 57, 58, 60, 61 and 63. We have jurisdiction under 35
 U.S.C. § 6(b) (2002).

1 Appellants invented an absorbent pad including a single densified
2 layer having an edge compression between 2726 and 3615 gm-cm of energy
3 to 50% compression. (Specification 21, 37).

4 Claim 1 under appeal reads as follows:

5 1. An absorbent pad, comprising:

6 7 a single, densified layer including between 30 and 85
7 8 wt% superabsorbent material homogeneously mixed with
8 9 between 15 and 70 wt% pulp fluff;

10 11 wherein the single-layer absorbent pad has been
11 12 compacted to a density greater than about 0.28 grams per cubic
12 13 centimeter and a thickness in a range of between 0.5 and 3.0
13 14 millimeters, and the single-layer absorbent pad also has an
14 15 absorbent capacity between about 14 and 40 grams 0.9 w/v%
15 16 saline solution per gram of absorbent pad and an edge
16 17 compression between about 2726 and about 3615 gm- cm of
17 18 energy to 50% compression

19 20 The Examiner rejected claims 1 to 11, 15 to 30, 34 to 36, 58, 60, 61
21 and 63 under 35 U.S.C. § 102(b) as anticipated by Laux..

22 23 The Examiner rejected claims 12 to 14 and 31 to 33 under 35 U.S.C.
23 § 103(a) as being unpatentable over Laux in view of Coles.

24 25 The Examiner rejected claims 37 to 39 under 35 U.S.C. § 103(a) as
25 being unpatentable over Laux.

26 27 The Examiner rejected claim 57 under 35 U.S.C. § 103 as being
27 unpatentable over Laux in view of Pieniak.

28 29 The prior art relied upon by the Examiner in rejecting the claims on
29 appeal is:

30

1 Pieniak US 5,451,442 Sep. 19, 1995

2 Coles US 5,722,967 Mar. 03, 1998

3 Laux US 5,827,259 Oct. 27, 1998

4 Appellants contend that Laux does not disclose an absorbent pad
5 having an edge compression between about 2726 and about 3615 gm-cm of
6 energy to 50% compression.

7 ISSUES

8 Have Appellants shown that the Examiner erred in finding that Laux
9 discloses an absorbent pad having an edge compression between about 2726
10 and about 3615 gm-cm of energy to 50% compression.

11
12 FINDINGS OF FACT

13 Appellants' invention is an absorbent pad that has an edge
14 compression between about 2726 and about 3615 gm-cm of energy of 50%
15 compression. The Specification discloses that the edge compression is a
16 measure of the stiffness of the pad (Specification 7). Humidification and the
17 use of an embossing pattern during the formation of the absorbent pad
18 reduces the stiffness and thereby the edge compression (Specification 7, 27-
19 28).

20 The Specification teaches that the basis weight of the pad is between
21 80 to 1000 gsm, preferably between 100 to 800 gsm, and even more
22 preferably between 120 to 750 gsm (Specification 27). The pad is sent
23 through a densification process that is accomplished with a conventional
24 compaction roll or more preferably a heated nip (Specification 27). Once
25 densified, the thickness of the pad is between 0.4 and 3.0 mm, preferably
26 between 0.5 mm and 2.5 mm and more preferably between 0.6 and 2.0 mm

1 (Specification 27). The absorbent pad is comprised of between 30 and 85
2 wt%, more preferably between 50 and 75 wt% superabsorbent material
3 homogeneously mixed with between 15 and 70 wt% , more preferably
4 between 20 and 60 wt% pulp fluff (Specification 13). The pad has an
5 absorbent capacity of between 14 and 40 (Specification 14).

6 Laux discloses an absorbent pad comprised of between 30% and 75%
7 superabsorbent material homogeneously mixed with between 25% and 75%
8 pulp fluff (col. 19, ll. 50 to 65) with an absorbency capacity of 32 to 48 (col.
9 19, ll. 26 to 27). The pad has a weight from 400 to 900 gsm, an average
10 weight of 500 to 800 gsm and preferably 550 to 750 gsm (col. 19, l. 67 to
11 col. 20, l. 6). The thickness is less than 5.3 mm (col. 20, ll. 9 to 11). Laux
12 discloses nothing about the edge compression or stiffness of the pad.

13 The Examiner reasons that since the absorbent pad of Laux is
14 comprised of the same material as the claimed invention, and has the same
15 density, thickness, and absorbent capacity, Laux inherently discloses a pad
16 having the claimed edge compression.

17 Laux discloses nothing about humidification or using an embossing
18 pattern. The Laux pad does not *necessarily* have an edge compression of
19 2726 to 3615 gm-cm of energy to 50% compression.

20
21 PRINCIPLES OF LAW

22 The prior art reference need not expressly disclose each claimed
23 element in order to anticipate the claimed invention. *See Tyler Refrigeration*
24 *v. Kysor Indus. Corp.*, 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed.
25 Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior
26 art reference, then that element (or elements) is disclosed for purposes of

1 finding anticipation. *See Verdegaal Bros., Inc. v. Union Oil Co. of
2 California*, 814 F.2d 628, 631-33, 2 USPQ2d 1051, 1052-54 (Fed. Cir.
3 1987).

4 It is well settled that the burden of establishing a prima facie case of
5 anticipation resides with the Patent and Trademark Office (PTO). *See In re
6 Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When
7 relying upon the theory of inherency, the examiner must provide a basis in
8 fact and/or technical reasoning to reasonably support the determination that
9 the allegedly inherent characteristic necessarily flows from the teachings of
10 the applied prior art. *See Continental Can Co. v. Monsanto Co.*, 948 F.2d
11 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); *Ex parte Levy*, 17
12 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). Inherency, however,
13 can not be established by probabilities or possibilities. The mere fact that a
14 certain thing may result from a given set of circumstances is not sufficient.
15 948 F.2d. at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578,
16 581, 212 USPQ 323, 326 (CCPA 1981)).

17 After the PTO establishes a prima facie case of anticipation based on
18 inherency, the burden shifts to the appellant to prove that the subject matter
19 shown to be in the prior art does not possess the characteristics of the
20 claimed invention. *See In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964,
21 966 (Fed. Cir. 1985); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138
22 (Fed. Cir. 1986).

1 ANALYSIS

2 Laux does not necessarily disclose that the pad has an edge
3 compression between about 2726 and about 3615, which is required by each
4 of the rejected claims. While the Laux pad may have the claimed edge
5 compression, the Examiner has not established that the claimed edge
6 compression of the Laux pad *necessarily flows* from the Laux disclosure.
7 The edge compression of the claimed pad is achieved by humidification or
8 pattern embossing of the pad during formation of the pad. The Examiner
9 has not directed our attention to any disclosure in the Laux references related
10 to any humidification or pattern embossing of the therein disclosed pad.
11 Therefore, it can not be established that the claimed edge compression is
12 inherent in the Laux pad.

13 In addition, since Laux does not disclose the edge compression of the
14 pad or the process of humidification or pattern embossing, Laux does not
15 suggest that the pad has the claimed edge compression.

16 In each of the Examiner's rejections, the Examiner relies on Laux for
17 teaching or suggesting the claimed edge compression. We do not find the
18 requisite teaching or suggestion in Laux. The remaining references do not
19 cure this deficiency of Laux. Therefore, we will not sustain any of the
20 rejections of the Examiner.

21 The decision of the Examiner is reversed.

22

23 REVERSED

24

25

26 vsh

Appeal 2006-3438
Application 09/939,061

1 PAULEY PETERSEN & ERICKSON
2 2800 WEST HIGGINS ROAD
3 HOFFMAN ESTATES IL 60169